Customer No. 22,852
Attorney Docket No. 09812.0626-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)
	)
Manabu KII et al.	) Group Art Unit: 2163
	)
Application No.: 10/027,194	) Examiner: KINDRED, Alford W.
	)
Filed: December 20, 2001	)
	)
For: SERVICE OFFERING SYSTEM,	) Confirmation No.: 9663
MANAGEMENT SERVER,	)
SERVICE PROVIDER, TERMINAL	)
DEVICE, STORAGE MEDIUM	)
ISSUING APPARATUS, SERVER	)
OFFERING METHOD, AND	)
STORAGE MEDIUM	)

Attention: Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

APPEAL BRIEF UNDER BOARD RULE § 41.37

In support of the Notice of Appeal filed November 15, 2005, and further to Board

Rule 41.37, Appellants present this brief and enclose herewith a check for the fee of

$500.00 required under 37 C.F.R. § 1.17(c).

This Appeal Brief is being filed concurrently with a petition for an Extension of

Time for TWO (2) months, and the appropriate fee.

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This Appeal responds to the pre-appeal brief review mailed on

December 22, 2005 and the Final Office Action mailed September 15, 2005, which

rejected claims 1-10, 12-14, and 26 under 35 U.S.C. § 103(a).

If any additional fees are required or if the enclosed payment is insufficient, Appellants request that the required fees be charged to Deposit Account No. 06-0916.

I. REAL PARTY IN INTEREST

SONY Corporation is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

There are currently no other appeals or interferences, of which Appellants, Appellants' legal representative, or assignee are aware, that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-10, 12-14, and 26 remain pending and under examination. Claims 1-10, 12-14, and 26 stand rejected. Claims 11, 15-25, and 27-31 have been cancelled. Appellants appeal the rejection of claims 1-10, 12-14, and 26.

IV. STATUS OF AMENDMENTS

No amendments have been filed subsequent to the final rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claims 1, 7, 8, and 26 of this application recite a service offering system from a server to a terminal device. Such a service offering system may be used, for example, to provide services relative to package media. *Specification*, p. 1. Independent claim 10 recites a management server.

In prior art network service offering systems, users must transmit their credit card information to obtain services. *Id.* This is undesirable because of the potential for credit card information to be intercepted. *Id.* Some prior art network service offering systems

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solve this problem by requiring the media, not the user who purchased the service, to be eligible for services offered. *Id.* at 1-2. These systems, however, are incapable of distinguishing between legitimate media and their illegal copies. *Id.* at 2.

Other prior art systems require users to contract with a particular service provider before the user is allowed access to the services offered by the provider. *Id.* These systems require a user to create a personal ID, password, and access point, which is both tedious and time-consuming. *Id.*

The present invention solves the problems described above in the prior art service offering systems. *Id.*

Independent claim 1 recites a service offering system from a server (Fig. 1, 505) to a terminal device (Fig. 1, 503). The system includes a recording means (Fig. 1, 501) for recording a unique identifier to each of a plurality of package storage media (Fig. 1, 51) issued (*Specification* at 14, lines 6-7; 37, lines 1-12); a database (Fig. 1, 505a) for storing and managing the identifiers (*Specification* at 21, lines 15-21); a reading means (*Specification* at 16, lines 1-6) for reading the recorded identifier from any of the package storage media at the terminal device (*Specification* at 55, lines 13-17; 69, lines 10-14); a checking means (Fig. 3, 513; Fig. 4, 513) for checking the identifier read by the reading means against the identifiers managed in the database (*Specification* at 16, lines 7-16; 20, lines 16-18; 21, lines 6-9; 24, lines 12-21). The system also includes a service offering means (Fig. 1, 504) for offering a service to the terminal device corresponding to the package storage medium identified by the checked identifier depending on a result of the check by the checking means (*Specification* at 16, lines 17-24; 17, line 1; 23, lines 7-10).

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Independent claim 7 recites a service offering system from a server (Fig. 1, 505) to a terminal device (Fig. 1, 503). The system includes a storage medium issuing means (Fig. 1, 501) including recording means (*Specification* at 14, lines 6-7) for recording a unique identifier to each of a plurality of package storage media (Fig. 1, 51) issued (*Specification* at 14, lines 3-5; 37, lines 1-12); a management server (Fig. 1, 505) including a database (Fig. 1, 505a) for storing and managing the identifiers recorded to the package storage media issued by the storage medium issuing means (*Specification* at 21, lines 15-21); a checking means (Fig. 3, 513; Fig. 4, 513) for checking the identifier read by the terminal device against the identifiers managed in the database (*Specification* at 16, lines 7-16; 20, lines 16-18; 21, lines 6-9; 24, lines 12-21); and a service provider (Fig. 1, 504) including service offering means (Fig. 4, 522) for offering a service to the terminal device corresponding to the package storage media depending on a result of the check by the checking means (*Specification* at 16, lines 17-24; 17, line 1; 23, lines 7-10). The terminal device includes a reading means (*Specification* at 16, lines 1-6) for reading the recorded identifier from any of the package storage media (*Specification* at 55, lines 13-17; 69, lines 10-14).

Independent claim 8 recites a service offering system from a server (Fig. 1, 505) to a terminal device (Fig. 1, 503). The system includes a storage medium issuing means (Fig. 1, 501) including recording means (*Specification* at 14, lines 6-7) for recording a unique identifier to each of a plurality of package storage media issued (Fig. 1, 51; *Specification* at 14, lines 3-5; 37, lines 1-12) and a service provider (Fig. 1, 504) including service offering means (Fig. 4, 522) for offering a service to the terminal device corresponding to the package storage media depending on a result of

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checking the identifier in question against the identifiers managed in the database and according to the right information stored in the database in correspondence with the checked identifier (*Specification* at 16, lines 17-24; 17, line 1; 23, lines 7-10). The server includes a database (Fig. 1, 505a) which stores the identifiers and retains, in correspondence with the identifiers, right information which denotes services available to the package storage media identified by the identifiers (*Specification* at 21, lines 15-21). The terminal device includes a reading means (*Specification* at 16, lines 1-6) for reading the recorded identifier from any of the package storage media (*Specification* at 55, lines 13-17; 69, lines 10-14).

Independent claim 10 recites a management server (Fig. 1, 505). The management server includes a receiving means (Fig. 3, 511) for receiving right information that denotes services available to a package storage medium (Fig. 1, 51; *Specification* at 19, lines 22-24; 20, lines 1-6). The receiving means also receives identifiers from the package storage medium, where an issuing party issues a plurality of storage media identified by said identifiers which differ from one another (*Specification* at 14, lines 22-24; 15, lines 1-2; 37, lines 4-5). The management server also includes a storing means (Fig. 3, 505a) and a checking means (Fig. 3, 513). The storing means stores right information corresponding to each of the identifiers in a database (*Specification* at 20, lines 7-11). The checking means checks the identifier transmitted from a terminal device (Fig. 1, 503) by way of a service provider (Fig. 1, 504) against the identifiers stored in the storing means (*Specification* at 20, lines 15-24).

Independent claim 26 recites a service offering method for offering a service from

a server (Fig. 1, 505) to a terminal device (Fig. 1, 503). The method includes the steps

of recording a unique identifier to each of a plurality of package storage media

(Fig. 1, 51) issued (*Specification* at 14, lines 3-15); storing the identifiers into a database

(*Specification* at 21, lines 15-21); reading the recorded identifier from any of the

package storage media at the terminal device (*Specification* at 15, lines 21-24; 16,

lines 1-6); checking the identifier read from the package storage medium against the

identifiers stored in the database (*Specification* at 16, lines 7-13); and offering a service

to the terminal device corresponding to the package storage medium identified by the

checked identifier (*Specification* at 16, lines 17-24; 17, line 1).

VI. GROUNDS OF REJECTION

Claims 1-10, 12-14, and 26 stand rejected under 35 U.S.C. § 103(a) as being

unpatentable over U.S. Patent No. 6,119,133 to Nusbickel et al. ("*Nusbickel*") in view of

U.S. Patent Publication No. 2002/0010684 to Moskowitz ("*Moskowitz*"), and U.S. Patent

Publication No. 2002/0174010 to Rice, III ("*Rice*").

VII. ARGUMENTS

In view of the following arguments, Appellants respectfully request the Board to

reverse the Examiner's rejection of claims 1-10, 12-14, and 26.

A. Claims 1-6 and 26 Patentably Distinguish
Over *Nusbickel, Moskowitz, and Rice*

Nusbickel, Moskowitz, and *Rice,* alone or in combination, do not disclose a

"reading means for reading the recorded identifier from any of said package storage

media at said terminal device," as recited in claim 1.

Nusbickel discloses an information processing system, where the web server application 103 determines a unique ID 401 to retrieve a corresponding image file 201 (*Nusbickel* at column 5, lines 23-26; 56-63). Determining a unique ID <u>at a web server</u> using a server application does not constitute a "reading means for reading the recorded identifier...<u>at said terminal device</u>," as recited in claim 1.

Neither *Moskowitz* nor *Rice* cures this deficiency in *Nusbickel*, nor does the Examiner rely on these references for this teaching (Final Office Action at 2). Accordingly, the Examiner's rejection of claim 1 as being unpatentable by *Nusbickel*, *Moskowitz*, and *Rice* should be reversed.

Additionally, *Nusbickel*, *Moskowitz*, and *Rice*, alone or in combination, do not disclose a "checking means for checking the identifier read by said reading means against said identifiers managed in said database," as recited in claim 1.

Nusbickel discloses determining a unique record ID 401 when application 103 retrieves the database entry (*Nusbickel*, column 5, lines 23-25). An image file 305 is then named according to the unique record ID (*Nusbickel*, column 5, lines 11-13). The image file, along with other database records 400, is used to fill-in the HTML webpage, which is then sent to the user unit 109 for display on the user's browser 111 (*Nusbickel*, column 5, lines 59-63).

Determining a unique ID, naming an image file according to the unique ID, and sending the image file to a user's browser, as disclosed in *Nusbickel*, does not constitute a "<u>checking means for checking the identifier read by said reading means</u> against said identifiers managed in said database," as recited in claim 1.

Moskowitz does not cure this deficiency in Nusbickel. Moskowitz discloses

distributing digital content through a local content server ("LCS") (Moskowitz at

paragraph 0141). The LCS includes storage for content, authentication of content,

enforcement of export rules, and watermarking and hashing of exported content

(Moskowitz at paragraph 0147). The stored content may be on a rewritable medium,

such as a CD-R/W (Moskowitz at paragraphs 0147, 0150; Figure 2, item 206). In

operation, content enters the LCS domain 204 from rewritable media 206 (Moskowitz at

paragraph 0162). Using a hash, the content is checked for the presence of a watermark

(Moskowitz at paragraph 0162).

Moskowitz does not disclose a "checking means for checking the identifier read

by said reading means against said identifiers managed in said database," as recited in

claim 1 because Moskowitz does not disclose the local content server ("LCS") checking

more than one identifier. Moskowitz discloses "a watermark for the particular LCS"

(Moskowitz at paragraph 0162). This implies that there is only one identifier associated

with the LCS. Therefore, the LCS domain 204 does not store or manage more than one

identifier, which means the LCS domain cannot "[check] the identifier read by said

reading means against said identifiers managed in said database," as recited in claim 1.

Rice fails to cure this deficiency in Nusbickel and Moskowitz, nor does the

Examiner rely on Rice for this teaching (Final Office Action at 2). Accordingly, the

Examiner's rejection of claim 1 as being unpatentable by Nusbickel, Moskowitz, and

Rice should be reversed.

Nusbickel, Moskowitz, and Rice, alone or in combination, do not disclose a

"service offering means for offering a service to said terminal device corresponding to

the package storage medium identified by the checked identifier depending on a result

of the check by said checking means," as recited in claim 1.

Nusbickel discloses retrieving data from a database; determining the record ID

for the database record; filling-in the HTML webpage using database records, including

the image file associated with the record ID; and sending the HTML-compatible

webpage to the user for display on the user's browser (*Nusbickel*, column 5,

lines 46-63). *Nusbickel* is silent with respect to a service offering means that offers a

service based on a result of a checking means. Instead, *Nusbickel* sends data to a user

unit based solely on a search request, which is different than a "service offering means

for offering a service to said terminal device corresponding to the package storage

medium identified by the checked identifier <u>depending on a result of the check by said</u>

<u>checking means</u>," as recited in claim 1.

Moskowitz does not cure this deficiency in *Nusbickel*. First, *Moskowitz* does not

disclose a checking means as discussed above. Therefore, *Moskowitz* cannot disclose

a "service offering means for offering a service...depending on a result of the check <u>by</u>

<u>said checking means</u>," as recited in claim 1. In addition, independent of the checking

means, *Moskowitz* fails to disclose a "service offering means for offering a service to

said terminal device corresponding to the package storage medium identified by the

checked identifier depending on a result of the check by said checking means," as

recited in claim 1.

Moskowitz discloses checking a watermark in data content <u>sent from</u> a rewritable

medium (*Moskowitz* at paragraph 0162). *Moskowitz* also discloses the LCS

domain 204 exporting content to a rewritable medium and "rendering the content for use

(e.g., playing, viewing, etc)" (*Moskowitz* at paragraph 0164). The LCS domain 204

checks the watermark <u>sent from</u> a rewritable medium; the LCS domain <u>does not</u> check

the watermark before exporting or rendering content to the rewritable medium.

Therefore, *Moskowitz* does not disclose a "service offering means for offering a service

to said terminal device corresponding to the package storage medium identified by the

checked identifier <u>depending on a result of the check by said checking means</u>," as

recited in claim 1.

Rice does not cure this deficiency in *Nusbickel* and *Moskowitz*, nor does the

Examiner rely on *Rice* for this teaching (Final Office Action at 2). Accordingly, the

Examiner's rejection of claim 1 as being unpatentable in view of *Nusbickel*, *Moskowitz*,

and *Rice* should be reversed.

Independent method claim 26 recites subject matter paralleling that of

independent claim 1 and is allowable at least for the reasons presented above.

Furthermore, claims 2-6 are allowable based on their dependence from allowable

claim 1.

B. Claims 7-9 Patentably Distinguish Over
Nusbickel, Moskowitz, and *Rice*

Appellants respectfully request reversal of the rejection of independent claims 7

and 8 for the reasons presented above for claim 1. Additionally, the Examiner's

rejection of claims 7 and 8 as being unpatentable in view of *Nusbickel*, *Moskowitz*, and

Rice should be reversed because these references, taken alone or in combination, do

not disclose a "storage medium issuing means including recording means for recording

a unique identifier to each of a plurality of package storage media issued," as recited in

claims 7 and 8.

Nusbickel discloses a database with data entries, where data stored in the data entries are sent to an end-user (*Nusbickel*, column 5, lines 1-14, 54-63). Sending data is not the same as a "storage medium issuing means including recording means for recording a unique identifier to each of a plurality of package storage media issued."

Moskowitz does not cure this deficiency in *Nusbickel*. *Moskowitz* discloses "[p]hysical shipment of packaged goods," including "a DVD for music or video," where the packaged goods may included value-added information (*Moskowitz* at paragraph 0229). Though *Moskowitz* discloses the physical shipment of goods with value-added information, this does not teach or suggest that the means by which the packaged goods are physically shipped includes a "means for recording a unique identifier to each of a plurality of package storage media issued." Thus, *Moskowitz* does not disclose a "storage medium issuing means including recording means for recording a unique identifier to each of a plurality of package storage media issued," as recited in claims 7 and 8.

Rice does not cure this deficiency in *Nusbickel* and *Moskowitz*. *Rice* discloses tracking customers' purchase histories using customer-unique identifiers (*Rice* at paragraph 0124); a metafile system that "links together multiple files, file locations, and file systems, presenting them to a user as a single file grouping" (*Rice* at paragraph 0222); and "[providing] collaboration tools, file storage means, office suite programs and other types of desirable packages to the computer device user, such as premium channel packages" (*Rice* at paragraph 0104). Linking files together using a metafile system and providing desirable packages to a user does not constitute a "storage medium issuing means including recording means for recording a unique

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identifier to each of a plurality of <u>package</u> storage media <u>issued</u>," as recited in claims 7 and 8.

Therefore, since *Nusbickel*, *Moskowitz*, and *Rice*, alone or in combination, do not teach or suggest every claim element, the Examiner's rejection of claim 8 as being unpatentable by these references should be reversed.

Claim 9 is allowable based on its dependence from allowable independent claim 8.

C. Claims 10 and 12-14 Patentably Distinguish Over <u>Nusbickel, Moskowitz, and Rice</u>

Nusbickel, *Moskowitz*, and *Rice*, alone or in combination, do not disclose a "checking means for checking the identifier transmitted from a terminal device by way of a service provider against said identifiers stored in said storing means," as recited in claim 10.

Determining a unique ID, naming an image file according to the unique ID, and sending the image file to a user's browser, as described in *Nusbickel supra*, does not constitute a "<u>checking means</u> for checking the identifier transmitted from a terminal device by way of a service provider against said identifiers stored in said storing means," as recited in claim 10. Furthermore, the user terminal 109 transmits only search request information, which is not the same as "checking the identifier <u>transmitted from a terminal device</u> by way of a service provider," as recited in claim 10.

Moskowitz does not cure this deficiency in *Nusbickel*. *Moskowitz* discloses a rewritable media 206 that transfers data content, including a watermark and a hash, to a LCS domain 204, and the LCS domain 204 checks the incoming watermark (*Moskowitz* at paragraphs 0162-63). Checking an incoming watermark <u>in a LCS domain</u> is not the

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same as "checking the identifier transmitted from a terminal device by way of a service provider against said identifiers stored in said storing means," as recited in claim 10.

Rice does not cure this deficiency in *Nusbickel* and *Moskowitz*, nor does the Examiner rely on *Rice* for this teaching (Final Office Action at 2). Therefore, the Examiner's rejection of claim 10 as being unpatentable in view of *Nusbickel*, *Moskowitz*, and *Rice* should be reversed.

Nusbickel, *Moskowitz*, and *Rice*, alone or in combination, do not disclose "an issuing party that issues a plurality of storage media identified by said identifiers which differ from one another," as recited in claim 10.

Nusbickel discloses a database with data entries, where data stored in the data entries are sent to an end-user (*Nusbickel*, column 5, lines 1-14, 54-63). Sending data, as disclosed by *Nusbickel*, is not the same as "an issuing party that issues a plurality of storage media identified by said identifiers which differ from one another."

Moskowitz does not cure this deficiency in *Nusbickel*. *Moskowitz* discloses a rewritable media (*Moskowitz*, Figure 2, item 206) and a read only media (*Moskowitz*, Figure 2, item 208). Both media send to the LCS "a watermark for the particular LCS" (*Moskowitz* at paragraphs 0162, 0167). This implies that both watermarks are specific to the LCS and, thus, are the same. Because both watermarks are the same, *Moskowitz* does not disclose "an issuing party that issues a plurality of storage media identified by said identifiers which differ from one another," as recited in claim 10.

Rice does not cure this deficiency in *Nusbickel* and *Moskowitz*, nor does the Examiner rely on *Rice* for this teaching (Final Office Action at 2). Therefore, the

Examiner's rejection of claim 10 as being unpatentable in view of *Nusbickel, Moskowitz,* and *Rice* should be reversed.

Claims 12, 13, and 14 are allowable based on their dependence from now allowable claim 10.

VIII. CONCLUSION

For the reasons given above, pending claims 1-10, 12-14, and 26 are allowable and reversal of the Examiner's rejection is respectfully requested.

To the extent any further extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: March 20, 2006   By: _____
                                   Patrick L. Miller
                                   Reg. No. 57,502

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IX. CLAIMS APPENDIX

1. A service offering system from a server to a terminal device, comprising:

recording means for recording a unique identifier to each of a plurality of package storage media issued;

a database for storing and managing the identifiers;

reading means for reading the recorded identifier from any of said package storage media at said terminal device;

checking means for checking the identifier read by said reading means against said identifiers managed in said database; and

service offering means for offering a service to said terminal device corresponding to the package storage medium identified by the checked identifier depending on a result of the check by said checking means.

2. A service offering system according to claim 1, wherein said database stores, in correspondence with said identifiers, right information which denotes services available to said storage media identified by said identifiers.

3. A service offering system according to claim 1, wherein said recording means records to said storage media right information which denotes services available to said storage media identified by said identifiers together with said identifiers.

4. A service offering system according to claim 1, wherein said service offering means offers the service to the storage medium in accordance with the right information which denotes services available to said storage media identified by said identifiers.

5.   A service offering system according to clam 1, further comprising content

data storing means for storing a plurality of content data items;

wherein said service offering means allows relevant content data to be

downloaded from said content data storing means to the storage medium.

6.   A service offering system according to claim 1, wherein said service

offering means allows relevant content data to be uploaded from the storage medium.

7.   A service offering system from a server to a terminal device, comprising:

storage medium issuing means including recording means for recording a unique

identifier to each of a plurality of package storage media issued;

a management server including a database for storing and managing the

identifiers recorded to said package storage media issued by said storage medium

issuing means;

said terminal device including reading means for reading the recorded identifier

from any of said package storage media;

checking means for checking the identifier read by said terminal device against

said identifiers managed in said database; and

a service provider including service offering means for offering a service to said

terminal device corresponding to said package storage media depending on a result of

the check by said checking means.

8.   A service offering system from a server to a terminal device, comprising:

storage medium issuing means including recording means for recording a unique

identifier to each of a plurality of package storage media issued;

the server including a database which stores the identifiers and retains, in correspondence with said identifiers, right information which denotes services available to said package storage media identified by said identifiers;

the terminal device including reading means for reading the recorded identifier from any of said package storage media; and

a service provider including service offering means for offering a service to said terminal device corresponding to said package storage media depending on a result of checking the identifier in question against said identifiers managed in said database and according to the right information stored in said database in correspondence with the checked identifier.

9.   A service offering system according to claim 8, wherein said service provider includes content data storing means for storing a plurality of content data items;

wherein said service offering means includes judging means for judging whether or not the corresponding right information indicates permission to download, said service offering means further reading relevant content data from said content data storing means and transferring the content data to said terminal device in accordance with the judgment made by said judging means; and

wherein said terminal device receives the transferred content data and records the received data to the storage medium.

10.   A management server comprising:

receiving means for receiving right information that denotes services available to a package storage medium and identifiers from said package storage medium an

issuing party that issues a plurality of storage media identified by said identifiers which differ from one another;

storing means for storing right information corresponding to each of the identifiers and said identifiers in a database; and

checking means for checking the identifier transmitted from a terminal device by way of a service provider against said identifiers stored in said storing means.

12.   A management server according to claim 10, wherein said storing means stores, in correspondence with said identifiers sent from said storage medium issuing party, right information which denotes services available to said storage media identified by said identifiers.

13.   A management server according to claim 13, wherein said update information creating means creates update information for updating right information stored in said storing means in correspondence with said identifiers, as well as right information recorded on said storage media.

14.   A management server according to claim 13, wherein said update information creating means creates update information for updating right information stored in said storing means in correspondence with said identifiers, as well as right information recorded on said storage media.

26.   A service offering method for offering a service from a server to a terminal device, the method comprising the steps of:

recording a unique identifier to each of a plurality of package storage media issued;

storing the identifiers into a database;

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reading the recorded identifier from any of said package storage media at said

terminal device;

checking the identifier read from the package storage medium against said

identifiers stored in said database; and

offering a service to said terminal device corresponding to the package storage

medium identified by the checked identifier.

X. EVIDENCE APPENDIX

Appellants do not rely on any evidence in this Appeal.

XI. RELATED PROCEEDINGS APPENDIX

To Appellants' knowledge, there are no related proceedings or decisions.